

are demonstrated in the data, e.g., reflexivity, elimination, signal enhancement and suitability for lymphography.

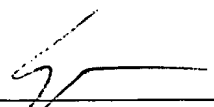
Even if the examiner were correct that there is motivation in the prior art to combine the diamagnetic and paramagnetic perfluoroalkyl compounds, this would only be for purposes of using the diamagnetic compounds in combination with the paramagnetic compounds solely for reasons having nothing to do with MRI properties. Thus, it is completely unexpected that the combinations would have the shown effects. Even one such unexpected property is sufficient to establish nonobviousness. See, for instance, *In re Chupp* 816 F.2d 643, 2 USPQ2d 1437 (Fed. Cir. 1987).

The examiner has cited 2 references showing that diamagnetic perfluoroalkyl compounds are suitable for use as surfactants in conjunction with contrast media in general. This is a general principle being applied and underlies the rejection. There is nothing to expect that any particular prior art such agent would produce results any different from any other such prior art diamagnetic perfluoroalkyl compound. And, as mentioned above, there is nothing of record to indicate that any such diamagnetic compound would have any effect on the MRI properties tested in the accompanying declaration. Accordingly, prior art diamagnetic perfluoroalkyl compounds are equally situated with respect to this invention. Furthermore, the accompanying data exemplify two different such diamagnetic agents and two different paramagnetic perfluoroalkyl agents. Since there is no reason to expect different results with different agents in either of these classes, the data are fully satisfactory under the law. *In re Saunders*, 444 F.2d 599, 170 USPQ 213 (CCPA 1971).

It is thus respectfully submitted that this application is now in condition for allowance.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,



Anthony J. Zelano, Reg. No. 27,969
Attorney for Applicants

MILLEN, WHITE, ZELANO
& BRANIGAN, P.C.
Arlington Courthouse Plaza 1, Suite 1400
2200 Clarendon Boulevard
Arlington, Virginia 22201
Telephone: (703) 243-6333
Facsimile: (703) 243-6410

Attorney Docket No.: SCH-1722

Date: November 19, 2004
AJZ:bef K:\Sch\1722\Reply.doc